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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MPJ-DI

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Application Number

10/608,885

Filed

JUNE 27, 2003

First Named Inventor

KEANE, ROBERT

Art Unit

2625

Examiner

GARCIA, GABRIEL I.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.

Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 41,065

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DECEMBER 6, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant believes errors exist in the final rejection and respectfully requests a review. More specifically, Applicant believes that limitations in the pending claims are clearly not met by the cited reference.

Claims 1 and 3-71 are pending. All pending claims relate to methods for creating an electronic product design in which product design software tools are downloaded to a user computer to execute in the browser of the user computer and which allow the user of the user computer to edit a downloaded product design template *at the user computer* to create a custom product design. As described in paragraphs [0063] and [0064] of the Applicant's specification and shown in Applicant's FIG. 3, the claimed methods allow a customer to design their own print job, using a design tool executing in the browser of the user's computer for design selection and editing. The design tool uses a user-friendly "what you see is what you get" ("WYSIWYG") functionality that allows the customer to choose a base design (e.g., the product design template) for a desired printed item (e.g., business card or stationery), and then edit the design. The "WYSIWYG" functionality of the design tool allows the customer to immediately see what the final printed item will look like even as the customer edits the downloaded design template. Thus, using the browser and a design tool downloaded to and executing within the browser of the user computer, the customer can choose a printed item from a wide selection of print products (e.g., business cards, letterhead, invitations, brochures and marketing materials), view a variety of images of *design templates* that are available for a selected print product (for example, different design templates for a selected business card product), choose one of the design templates, download the chosen design template to the user's computer, complete the design template (e.g., by supplying new text, uploading graphics files and adjusting fonts), and save the resulting design. The customer can then add the item to a web-based shopping cart and place an order. Key to claimed invention is that upon the user's selection of one of the offered design template images, an *editable* product design template associated with the selected template image is *downloaded to the user's*

computer where it is *edited* by the user *at the user computer* to create a custom electronic product design *at the user computer*. Importantly, all editing of the downloaded template is performed at the user computer.

The Examiner has rejected Claims 1 and 3-71 under 35 U.S.C. 102(e) as being anticipated by Laverty et al. (US 6,362,895), which discloses an online automated printing system in which a customer goes to the web site and selects a particular product to order. The web site loads a pre-configured order form of the selected product, and the customer enters the data they wish to appear on the product. The web site then transmits the data to the system, where it is combined *at the web site server 408* (by Farm 414) with product setup data stored in the ILIAD 410 database to generate a Print Ready File (col. 9, line 47 to col. 10, line 18; col. 19, lines 26-28 and col. 20, lines 48-62).

Importantly, the pre-configured order form presented to the user is not an editable *product design* template. Rather, as discussed in Laverty, the pre-configured order form is merely a means for prompting the user for text information and graphical elements (see Laverty, col. 20, lines 30-37). However, nothing in Laverty teaches or suggests that the pre-configured order form is presented in a "WYSIWYG" form to display to the user what the product design to be printed will look like. Thus, it is not a product design template as claimed in Applicant's claimed invention.

Turning now to the specific elements of Applicant's Claim 1, Laverty does not teach or suggest "downloading one or more product design software tools to a user computer, the tools being adapted to execute in the browser of the user computer and allow the user of the user computer to *edit a downloaded product design template at the user computer to create a custom product design*". In the Laverty system, a product design template is never downloaded to the user. Rather, a pre-configured order form is presented to the user prompting the user for user-specific personalized data. When entering user-specific personalized data, the user is not editing a product design template downloaded onto the user computer as claimed in Applicant's claims. Rather, the user-entered data is transmitted back to the server 408 which instructs the Farm 414 to generate a Print Ready

File (PRF) 412 containing the product design. As explained above, the Print Ready File (PRF) containing the customized product is created *at the server 408* by the Farm 414, as opposed to *at the user computer* as claimed by Applicant. Thus, Lavery teaches neither editing “a downloaded product design template” nor “product design software tools ... adapted to execute in the browser of the user computer and allow the user of the user computer to edit a downloaded product design template at the user computer to create a custom product design” as recited in Applicant’s Claim 1.

Lavery also does not teach or suggest “providing a plurality of template images for viewing by the user of the user computer, the images representing electronic product design templates editable at the user computer by the user”. First, there is no teaching of a product design template in Lavery. Lavery does not show a template in any figure and makes no mention of at all of displaying template images for viewing by the user. Looking at col. 9, lines 61-65, Lavery simply states that the customer “goes to the web site and selects a particular product to order”. There is no teaching that the product is customizable nor a teaching that the product presented to the user is a template that may be customized.

Second, even if the product presented to the user were to be considered a product design template, as described in detail above, Lavery still does not download the template to the user computer to allow it to be edited by the user at the user computer.

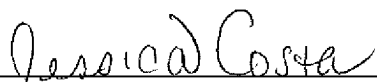
Lavery also does not teach or suggest “in response to the user’s selection of one of the template images, downloading an editable product design template associated with the selected template image, the downloaded product design template being a partially completed electronic product design”. Again, Lavery teaches nothing about “the downloaded product design template being a partially completed electronic product design”. In fact, because Lavery requires generation of the PRF by the server 408 and Farm 414, Lavery teaches away from any notion that the user might be allowed to have access at the user computer to an editable template.

Finally, for all of the reasons enumerated above, Lavery also does not teach or suggest “allowing the user to use one or more of the tools to *edit the downloaded template* to incorporate content *at the user computer* into the downloaded product design template to *create a custom electronic product design at the user computer*”.

The above comments regarding claim 1 are likewise applicable to independent claim 9 and 13 and to dependent claims 3-8, 10-12, and 14-71. In light of the above comments, it is believed that all pending claims are now allowable and favorable action on all claims is respectfully requested.

Respectfully submitted,

Date: December 6, 2007



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